

## REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

### I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-10 are currently pending. Claims 1, 6 and 8 are independent. Claims 1 and 2-10 are hereby amended. No new matter has been introduced. Support for this amendment is provided throughout the Specification as originally filed.

Changes to the claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

### II. TELEPHONE INTERVIEW

Applicant's attorney thanks the Examiner for granting the telephone interview on November 28, 2007. First, Applicant's attorney described the invention in broad terms, which, in one aspect, is charging a user a usage fee that is proportional to the user area size allocated to the corresponding user, recited in claim 1. Moreover, a second aspect includes superposing personal data of a user onto streaming content that is provided to the user to discourage unauthorized reproduction of the content, as recited in claim 8. In particular, the superposed

personal data is such that the user receiving the streaming content would not want others to have, thereby discouraging unauthorized reproduction of the content as recited in claims 9 and 10.

Second, Applicant's attorney and the Examiner discussed the §112 rejections related to "downloadable" content as related to streaming content. Applicant's attorney indicated the distinction is described in the specification in the Background pars. [0002]-[0003]. Applicant's attorney agreed to clarify the distinction by amending the claims to recite the provided streaming content "is not downloadable for permanent storage." The Examiner agreed to consider the clarifying amendment.

### **III. REJECTIONS UNDER 35 U.S.C. §112**

Claims 1-10 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement as stated in paragraph 3 of the Office Action.

Applicant disagrees with the application of the factors in paragraph 4 (a)-4(h). To the extent the allegations in paragraph 4(a)-4(h) are asserted as facts, Applicant denies those facts.

Claims 1, 6 and 8 have been amended to overcome the §112 rejection.

Applicant respectfully requests withdrawal of the §112 rejection of claims 1-10 of paragraph 3 of the Office Action.

Claims 1, 4-6 and 8 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Office Action paragraph 6.

The claims have been amended to clarify that the apparatus provides to each of a plurality of users a corresponding user area into which the apparatus copies content files selected by the user corresponding to that user area.

Applicant respectfully requests withdrawal of the §112 rejection of claims 1, 4-6 and 8 of paragraph 6 of the Office Action.

Claims 1 and 8 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Office Action paragraph 8.

Claims 1 and 8 have been amended to overcome the §112 rejection.

Applicant respectfully requests withdrawal of the §112 rejection of claims 1 and 8 of paragraph 8 of the Office Action.

Claims 1, 6 and 8 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Office Action paragraph 9.

Claims 1, 6 and 8 have been amended to overcome the §112 rejection. The amendments clarify the device only recites providing streaming content to the users.

Applicant respectfully requests withdrawal of the §112 rejection of claims 1, 6 and 8 of paragraph 9 of the Office Action.

#### **IV. REJECTIONS UNDER 35 U.S.C. §102**

Claims 1-9 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 6,154,771 to Rangan et al. (hereinafter merely “Rangan”).

Applicant respectfully traverses this rejection.

Independent claim 1 is representative and recites, *inter alia*:

“a user area of a predetermined size is allocated to each of said users for the storage of a content owned by a corresponding one of the users

...

wherein each of said users is charged a usage fee proportional to the user area size allocated to the corresponding user . . .” (Emphasis added)

As understood by the Applicants, Rangan describes, in relevant part, streaming hypervideo is received and played in a client-computer. Scene changes are detected and past scenes are displayed as thumbnail images. Hyperlinks with text annotations are provided and inserted in the thumbnails. Hyperlinking permits retrieving information and commercials, including streaming video, from any of local storage or a network content provider.

In contrast, claim 1 recites, “a user area of a predetermined size is allocated to each of said users . . . wherein each of said users is charged a usage fee proportional to the user area size allocated to the corresponding user.” That is, in an aspect of the present invention, the user is charges a fee based on the size of the area allocated to the user as opposed to the user being charged a fee based on the number of files or each file size.

The above-mentioned content delivery system charges a usage fee on the user for the user area size appropriated by the user, not for each content file copied into the user area. The charging scheme based on the user area size enables the system to collect fees reliably on the services rendered for the user. The larger the amount of contents the user wants to purchase, the larger the size of the user area needed to accommodate the purchased contents. The service provider can gain more earnings the larger the user area size under contract with each user. This system enables the user to take streaming delivery of the content file copied into the applicable

user area. Each corresponding user receives one content file being streamed, and it is possible for the system to charge unfailingly each of a large number of such users on each content file being streamed toward the corresponding user.

Another advantage of this system for the user is that the contents file is copied to and held in the corresponding user area allocated under contract with the service provider. Thus, the content can be enjoyed by the user whenever desired, streamed from the corresponding user area under the user's own management regardless of whether the service provider currently offers the content file in question.

The Office Action points to Rangan col. 21, line 35 for the above recited elements of claim 1. However, at the cited location, Rangan discloses only that the information received may include a commercial. The Office Action asserts it is inherent that “a user (advertiser) is charged a usage fee for transmission to the corresponding user.”

First, there is no provider of information recited in claim 1. All the users receive streaming content from the system. Thus, there is no provider user and no provider user to be charged the fee asserted in the Office Action. In the present invention, there are a plurality of users who can receive streaming content from the system. Each user has a corresponding user area and the user corresponding to that area is charged a fee based on the size of the area. There is no suggestion in Rangan that the users are “charged a usage fee proportional to the user area size allocated to the corresponding user” as recited in claim 1.

Second, Applicant asserts the Office Action improperly relies on inherency.

From MPEP 2112(IV): “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic . . . To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” (citations omitted). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

The Office Action cites Rangan for the claim 1 element, “each of said users is charged a usage fee proportional to the user area size allocated to the corresponding user.” The Office Action relies on inherency stating, “[t]he transmission of advertisements by inherency teaches a user (advertiser) is charged a usage fee for transmission to the corresponding user.” Nor is it inherent such a fee is based upon the size of a storage area assigned by the system to that corresponding user. Rangan merely states a user may “receive information that may include a commercial.” There is no indication the user is charged a fee nor even that the advertiser is charged a fee. It is not clear that Rangan even applies to the claim 1 elements at all. However, Applicant contends it is not inherent that an advertiser is charged a fee.

The Office Action fails to “provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” (emphasis added). MPEP 2112.

The recited elements are not disclosed in Rangan. Thus, claim 1 is patentable over Rangan because that reference does not disclose each and every element recited in the claim.

For reasons similar or somewhat similar to those described above with regard to independent claim 1, independent claims 6 and 8 are also believed to be patentable.

#### V. REJECTIONS UNDER 35 U.S.C. §103(a)

Claim 10 was rejected under 35 U.S.C. §103(a) as allegedly obvious over Rangan and Official Notice.

Applicant respectfully traverses this rejection.

Claim 10 is depends from claim 8 and is believed patentable for at least the same reasons. Moreover, claim 10 recites the additional feature, “the personal information includes the corresponding user’s credit card number, telephone number, address, and name” of the corresponding user are superposed on the streaming display. The Office Action asserts “any information could be inserted into the video of Rangan because Rangan allowed for customizable text captions.” The Office Action asserts the display of the corresponding user’s credit card number, telephone number, address and name would be obvious “to allow for identification of the source of the video, and to further allow for generous benefactors to

facilitate purchases and personal credit alterations by other users over the Internet by using the generous benefactor's credit information."

As discussed above, in relevant part, the invention of claim 10 is a content provider that provides content information to a corresponding user who requested the information. The provider superposes personal information about the corresponding user on the streaming content provided. That is, a user requests information that is streamed to the user with the user's personal information superposed thereon. The source of the video copies of the streaming data would then be the user to whom the video was streamed from the content provider, not the author of the content.

It is Applicant's idea for superposing on the streaming content such personal information of the corresponding user (*i.e.* the user to whom the content is streamed) as to discourage the corresponding user from making unauthorized copies of the streaming content and then distributing those copies to others. That is, the personal information recited in claim 10 is that which a user would prefer not to have disclosed to other users. Just because it is possible to superpose data on streaming data does not make the superposition of any and all such information obvious. That is, the type of data superposed on the streaming content is of such a nature to achieve a purpose of discouraging unauthorized copying of the streaming content.

Applicant's assert claim 10 is patentable for the additional reasons discussed above.

## VI. DEPENDENT CLAIMS

The other claims are dependent from one of the claims discussed above and are therefore believed patentable for at least the same reasons. Because each dependent claim is also deemed



to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

### **CONCLUSION**

Claims 1-10 are in condition for allowance. In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference, or references, it is respectfully requested that the Examiner specifically indicate those portions of the reference, or references, providing the basis for a contrary view.


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In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

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